

REMARKS

Response to the Obviousness Rejections

In the outstanding Office Action, the Examiner withdrew previously raised obviousness rejections against claims 1-7 and 10-14, but raised new grounds of rejections under 35 U.S.C. §103(a), alleging that claims 1-7 and 10-14 are obvious over newly cited U.S. Patent No. 6,242,056 (hereinafter “the ‘056 Patent”) and the previously cited European Patent Application Publication No. 1013724 (hereinafter “the ‘724 Publication”). Specifically, the Examiner asserted that the ‘056 Patent discloses a paint composition containing transparent glass beads with a particle size of 10-20 microns and a colorant such as alumina, that the ‘724 Publication discloses a pigment mixture containing titanium oxide coated alumina (Al_2O_3) and bismuth oxychloride (BiOCl) that is useful for paint and cosmetics, and that it would have been obvious for one of ordinary skill in the art to incorporate the pigments disclosed by the ‘724 Publication into the composition disclosed by the ‘056 Patent and then adjust the amount and particle size of the components to yield the claimed invention of the present application.

Applicants respectfully disagree, for the following reasons:

First, the ‘056 Patent relates to paint compositions or coatings “for spray-painting automobiles, boats, aircrafts and home appliances” (see Abstract of the ‘056 Patent).

Particularly, the ‘056 Patent teaches that such paint compositions or coatings contain a curable resinous binder system with a cross-linkable polymer and a cross-linking agent, so that upon heating or ultraviolet exposure, the paint compositions or coatings will be cured to form a clear, hard, glasslike paint layer (see the ‘056 Patent, column 5, lines 8-13). It is therefore clear that the paint compositions or coatings disclosed by the ‘056 Patent, which are designed for spray-painting automobiles, boats, aircrafts and home appliances, are not compositions suitable for

“topical application to the skin,” as positively recited by claims 1-7 and 10-14 of the present application. Upon heating or ultraviolet exposure, such paint compositions or coatings will harden into a clear, glass-like paint layer, and no one ordinarily skilled in the art would ever be motivated to apply them onto the skin.

Second, the Examiner’s assertion that the ‘056 Patent discloses the use of “a colorant such as alumina” is incorrect. The ‘056 Patent does not disclose the use of alumina; instead, it discloses the use of aluminum flakes throughout the description (see, for example, the Abstract and column 2, line 30). It is important to note that aluminum flakes disclosed by the ‘056 Patent is not alumina, despite the Examiner’s assertion. Alumina is aluminum oxide (Al_2O_3), which is a metal oxide, while aluminum flakes contains aluminum in the un-oxidized, metallic form. Further, aluminum flakes are highly reflective but not very transmissible to light, i.e., little or no light can pass through them. Therefore, the aluminum flakes disclosed by the ‘056 Patent do not constitute the “non-interference platelet component exhibiting a light transmission value of about 20% to about 70% and a light reflectance value of about 10% to about 20%,” as positively recited by the independent claims 1 and 11 of the present application.

Third, it has been well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, even if a person ordinarily skilled in the art were motivated to incorporate the titanium oxide coated alumina (Al_2O_3) and bismuth oxychloride (BiOCl) pigments disclosed by the ‘724 Publication into the compositions disclosed by the ‘056 Patent, as asserted by the Examiner in the outstanding Office Action, the so modified or resulting compositions would still be paint compositions for spray-painting automobiles, boats, aircrafts

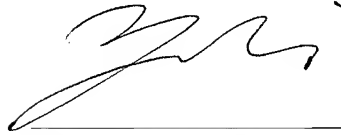
and home appliances, i.e., with a curable resinous binder system that upon heating or ultraviolet exposure will be cured to form a clear, hard, glasslike paint layer, which are not suitable for topical application to human skin. Any further modification of such compositions, for example, by removing the curable resinous binder system or otherwise adapting them for topical applications, would render the '056 invention unsatisfactory for its intended purpose, which is to coat the automobiles, boats, aircrafts and home appliances with a hard, translucent, and chip-resistant paint layer.

Based on the foregoing, it is clear that claims 1-7 and 10-14 of the present application patentably distinguish over the '056 Patent and the '724 Publication, by positively reciting a composition for topical application to the skin containing (a) a transparent component having a light transmission value of greater than 70% and (b) a non-interference platelet having a light transmission value of about 20% to about 70% and a light reflectance value of about 10% to about 20%. Such a combination of the non-interference platelet and the transparent component as specified hereinabove results in an improved cosmetic composition which, when applied to the skin, has the surprising and unexpected effect of diminishing or eliminating the appearance of skin blemishes, while at the same time permitting surrounding clear skin to retain its normal, healthy appearance (see the instant specification, page 2, lines 5-7), which is neither disclosed nor suggested by the '056 Patent and the '724 Publication.

Accordingly, Applicants respectfully request the Examiner to reconsider, and upon reconsideration to withdraw, the §103 rejection against the pending claims of the present application.

In view of the foregoing remarks, it is firmly believed that the present application is in condition for allowance, which action is again solicited.

Respectfully submitted,



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